

REMARKS

Applicant requests favorable reconsideration of this application in view of the foregoing amendments and the following remarks. Of claims 1-27 which were pending in the application, claims 1-20 were previously withdrawn and claims 21 and 23-27 were rejected in the Office Action. Applicants appreciate the indication of allowable subject matter in claim 22. In response to this positive indication, claim 22 has been amended to be in independent claim format. Applicants also amended claims 25 and 27 without adding new matter.

To expedite prosecution, Applicants have canceled non-elected claims 1-20, without prejudice or disclaimer. Applicants continue to reserve the right to file one or more divisional applications for these non-elected claims.

1. Objection to the I.D.S. filed 11/2/00

The Examiner objected to the I.D.S. filed on November 2, 2000 "because Applicant has not provided a translation of the foreign documents." Preliminarily, Applicants traverse this rejection in that Applicants are not required to provide an English translation of foreign patent documents, unless one is available. *See* M.P.E.P. § 609. Rather, all Applicants must do is provide "a concise explanation of the relevance, as it is presently understood by the individual designated in 37 C.F.R. § 1.56(c) most knowledgeable about the content of the information listed that is not in the English language." *Id.* Further, Applicants satisfied this duty by citing to the specification which discusses the listed Japanese references. *See id.*

However, to aid the Examiner, Applicants are concurrently filing another I.D.S. which includes three Great Britain references which correspond to the two Japanese references to which the Examiner objected. Specifically, Applicants are filing:

- (a) GB 2,129,691 and GB 2,169,265 which correspond to Japanese Provisional Patent Publication No. 59-88158; and
- (b) GB 2,178965 which corresponds to Japanese Provisional Patent Publication No. 62-41668.

2. Objection to the Abstract

The Examiner objected to the Abstract for various formalistic reasons each of which has been fully addressed by way of the replacement Abstract attached to this document. Accordingly, the objection is moot and should be withdrawn.

3. Rejection of Claims 21 and 23-27

The Examiner rejected claims 21 and 23-27 under 35 U.S.C. § 102(b) as being anticipation by U.S. Patent No. 4,778,054 (“Newell”). For the following reasons, Applicants respectfully traverse each of these rejections.

a. Claims 21, 23, and 24

Newell fails to teach or suggest each limitation of claim 21. Specifically, claim 21 recites (with italic emphasis added):

the blistered portion comprising:

- (a) *a pair of substantially hemispherical convex portions* in which inflow and outflow holes are pricked during a preliminary operation of inhalant medication; and
- (b) a flow-constriction portion formed between the substantially hemispherical convex portions to define a flow-constriction orifice passage.

An understanding of the recited “pair of substantially hemispherical convex portions” may be found in the embodiment shown in Figures 15-19 of the instant application. Specifically, in this embodiment two convex portions 23A, 23B are separated from each other by a flow-constriction portion 23C. *See p. 30, lines 6-12.*

By way of contrast, the annular region 140/150 in Newell does not define a “pair of substantially hemispherical convex portions,” as it defines one annular chamber. An understanding of the Newell device is provided at col. 6, line 65 – col. 7, line 12. This portion of Newell teaches that when an overfilled blister 91 (shown in Fig. 10) is pricked, the cover maintains some of the medication in annular region 140. Similarly, when an underfilled blister 91 (shown in Fig. 11) is pricked, the cover maintains some of the medication in annular region 150. In other words, Newell discloses a blister pack for an inhalant medicator in which each blister 91 is formed of a single conical container. Moreover, the problems discussed in Newell with respect to Figures 10 and 11 thereof are the same problems (*i.e.*, the failure to expel all medication via a linear airflow between an inlet and an aligned outlet) discussed in the Background of the instant application. *See p. 2, line 3 – p. 3, line 27 (discussing JP 59-88158).*

Accordingly, for at least the aforementioned reasons, Newell fails to teach or suggest a pair of substantially hemispherical convex portions with a flow-constriction portion formed between them, as recited in claim 21. As a result, Newell can not be used to reject claim 21 under 35 U.S.C. § 102(b). Further, as claims 23 and 24 depend from claim 21, each of these dependent claims is also allowable over Newell, without regard to the other patentable

limitations recited therein. Therefore, a withdrawal of the rejection of claims 21, 23, and 24 is both warranted and earnestly solicited.

b. Claim 25

Similar to claim 21, claim 25 recites: “a pair of shallow portions in which inflow and outflow holes are pricked during a preliminary operation of inhalant medication.” As previously discussed, Newell fails to teach or suggest a “pair of shallow portions” and, instead, teaches singular, annular regions 140/150. Accordingly, the same arguments previously set forth with respect to claim 21 apply equally to claim 25 and, therefore, claim 25 is also allowable over Newell. Therefore, Applicants respectfully request a withdrawal of the rejection of claim 25 under 35 U.S.C. § 102(b).

c. Claims 26 and 27

Claims 26 and 27 are identical except that claim 26 recites “a shallow portion at a side of the inflow hole and [] a deep portion at a side of the outflow hole” whereas claim 27 recites “a shallow portion at a side of the outflow hole and [] a deep portion at a side of the inflow hole.” Preliminarily, the Examiner’s application of Newell to both of these claims is entirely inconsistent in that Newell teaches one blister 91 which is best shown in Figures 10-13. Clearly, the shown blister 91 can not teach a shallow inflow/deep outflow while at the same time teaching a shallow outflow/deep inflow. However, regardless of this inconsistency, claims 26 and 27 are also allowable over Newell for the following additional reasons.

i. Claim 26

Assuming, *arguendo*, that Newell’s conical surface of the blister 91 is a sloped surface positioned between an inflow hole and an outflow hole, the surface does not define a “shallow portion at a side of the inflow hole” and a “deep portion at a side of the outflow hole.” Rather, Newell teaches the opposite, *i.e.*, the inflow hole is wider than the outflow hole. Accordingly, as Newell fails to teach or suggest each limitation of claim 26, the claim can not be anticipated by Newell under 35 U.S.C. § 102(b) and, therefore, the rejection of claim 26 should be withdrawn.

ii. Claim 27

As amended, claim 27 recites “an asymmetrical sloped surface which defines a shallow portion at a side of the outflow hole and defines a deep portion at a side of the inflow hole.” Again, assuming, *arguendo*, that Newell’s conical surface of the blister 91 is a sloped surface, the surface is clearly not “asymmetrical,” as recited in claim 27. Accordingly, Newell fails to teach at least this limitation of claim 27 and, therefore, can not be used to

reject the claim under 35 U.S.C. § 102(b). As a result, Applicants respectfully submit that the rejection of claim 27 should also be withdrawn.

CONCLUSION

For the aforementioned reasons, claims 21-27 are now in condition for allowance. A Notice of Allowance at an early date is respectfully requested. The Examiner is invited to contact the undersigned if such communication would expedite the prosecution of the application.

Respectfully submitted,

October 29, 2003
Date _____

By



Customer Number: 22428
FOLEY & LARDNER
3000 K Street, N.W.
Suite 500
Washington, D.C. 20007-5143

Pavan K. Agarwal
Registration No. 40,888
Frederic T. Tenney
Registration No. 47,131
Attorneys for Applicant

Telephone: (202) 672-5300
Facsimile: (202) 672-5399

THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY ADDITIONAL FEES WHICH MAY BE REQUIRED REGARDING THIS APPLICATION UNDER 37 C.F.R. §§ 1.16-1.17, OR CREDIT ANY OVERPAYMENT, TO DEPOSIT ACCOUNT NO. 19-0741. SHOULD NO PROPER PAYMENT BE ENCLOSED HEREWITH, AS BY A CHECK BEING IN THE WRONG AMOUNT, UNSIGNED, POST-DATED, OTHERWISE IMPROPER OR INFORMAL OR EVEN ENTIRELY MISSING, THE COMMISSIONER IS AUTHORIZED TO CHARGE THE UNPAID AMOUNT TO DEPOSIT ACCOUNT NO. 19-0741. IF ANY EXTENSIONS OF TIME ARE NEEDED FOR TIMELY ACCEPTANCE OF PAPERS SUBMITTED HEREWITH, APPLICANT HEREBY PETITIONS FOR SUCH EXTENSION UNDER 37 C.F.R. § 1.136 AND AUTHORIZES PAYMENT OF ANY SUCH EXTENSIONS FEES TO DEPOSIT ACCOUNT NO. 19-0741.

ABSTRACT

A) A blister pack for an inhalant medicator has a plurality of medical powder storage chambers spaced apart from each other in a circumferential direction. The inhalant medicator includes a pricking tool with a pair of parallel pins that prick inflow and outflow holes in one of the medical powder storage chambers during a preliminary operation of inhalant medication. The inflow and outflow holes are spaced apart from each other by a predetermined distance in a direction parallel to a lid panel of the blister pack to produce turbulent airflow within the medical powder storage chamber during inhalation during which the medical powder is inhaled by a patient's breathing. The medical powder storage chambers are dimensioned and designed to properly regulate or control properties of the airflow passing through the medical storage chamber, to ensure the airflow is suitable for the medical powder stored in the storage chamber.